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13 AT&T Intellectual Property II, L.P.

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28 Plaintiff TiVo Inc.

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
OAKLAND DIVISION

AT&T INTELLECTUAL PROPERTY I, L.P. and
AT&T INTELLECTUAL PROPERTY II, L.P.,

Plaintiffs,

v.

TIVO INC.,

Defendant.

TIVO INC.,

Counterclaim Plaintiff,

v.

AT&T INTELLECTUAL PROPERTY I, L.P. and
AT&T INTELLECTUAL PROPERTY II, L.P.,

Counterclaim Defendants.

**JOINT STIPULATION TO AMEND
TIVO INC.'S INVALIDITY
CONTENTIONS PURSUANT TO
PATENT L.R. 3-6**

Case No. 4:10-CV-01059-SBA

1 **I. AMENDMENT TO TIVO'S INVALIDITY CONTENTIONS PURSUANT**
 2 **TO PATENT L.R. 3-6**

3 On August 23, 2010, Defendant TiVo Inc. served its Invalidity Contentions on Plaintiffs
 4 AT&T Intellectual Property I, L.P. and AT&T Intellectual Property II, L.P. On September 15,
 5 2010, Defendant served its First Amended Invalidity Contentions, which contained one minor
 6 change, namely the inclusion of a claim element under Defendant's §§ 101 and 112 defenses. On
 7 December 3, 2010, Defendant filed reexamination requests for the four patents-in-suit asserted by
 8 AT&T: United States Patent Nos. 5,809,492 ("492"), 5,922,045 ("045"), 6,118,976 ("976"),
 9 and 6,983,478 ("478") '478 patent. The reexamination requests for the '045 patent and the '976
 10 patent are based on prior art references which were not of record during the original prosecutions,
 11 and also not included in Defendant's original invalidity contentions.

13 In connection with its petitions for reexamination of the patents-in-suit, Defendant became
 14 aware of prior art references significant to patentability that were not included in its original
 15 invalidity contentions. Defendant has attempted to be diligent concerning discovery of prior art
 16 during this litigation and does not seek to amend its contentions for any improper purpose.
 17 Defendant requested and Plaintiffs agreed to allow Defendant to amend its First Amended
 18 Invalidity Contentions to include the additional references.

21 **II. STIPULATION**

22 THEREFORE, THE PARTIES HEREBY STIPULATE, by and through their respective
 23 counsel, and respectfully request that the Court find that Defendant has satisfied the good cause
 24 requirement of Patent L.R. 3-6, and that Defendant shall be permitted to amend its First Amended
 25 Invalidity Contentions to include additional references.

1 Dated: December 28, 2010

/s/ Kevin E. Cadwell
Kevin E. Cadwell

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8 Attorneys for Plaintiffs AT&T Intellectual
9 Property I, L.P. and AT&T Intellectual Property
10 II, L.P

11 Dated: December 28, 2010

/s/ Azar Mouzari
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18 Attorneys for Defendant TiVo Inc.

22 PURSUANT TO STIPULATION, IT IS SO ORDERED

24 Date: 12/30/10


25 Hon. Saundra B. Armstrong
United States District Judge

ATTESTATION OF CONCURRENCE

I hereby attest that concurrence in the filing of the document has been obtained from each of the other signatories in lieu of their signature(s) on the document.

By: /s/ Azar Mouzari
Azar Mouzari

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2 **CERTIFICATE OF SERVICE**

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4 I hereby certify that on December 28, 2010, I electronically filed the foregoing with the
5 Clerk of the Court using the CM/ECF system which will send notification of such filing to the e-
6 mail addresses on file with the Clerk of Court.

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8 By: /s/ Azar Mouzari
9 Azar Mouzari

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